



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,892	05/29/2001	Stephen Christopher Porter	8600-0015	5581

20855 7590 10/30/2002

ROBINS & PASTERNAK LLP
545 MIDDLEFIELD ROAD
SUITE 180
MENLO PARK, CA 94025

EXAMINER

IZAGUIRRE, ISMAEL

ART UNIT	PAPER NUMBER
----------	--------------

3765

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,892

Applicant(s)

PORTER, STEPHEN
CHRISTOPHER

Examiner

Ismael Izaguirre

Art Unit

3765

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33, 37-43 and 45-49 is/are rejected.
- 7) ☒ Claim(s) 34-36 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3765

DETAILED ACTION

SPECIFICATION

Abstract

The Abstract of the Disclosure is objected to because it lacks a statement of the technical disclosure of the patent. A more specific description of the structure of the vaso-occlusive elements would be appreciated by a member of the public looking at the front page of the patent.

Informalities

The specification is objected to because of the following informality:

On page 5, lines 25 and 26, the words "elements also an aspects". Appropriate correction is required.

CLAIMS

Summary

Claims 1 and 27 are the independent claims under consideration in this Office Action.

Claims 2-26 and 28-49 are the dependent claims under consideration in this Office Action.

Claim Rejections - 35 U.S.C. § 112

Claims 1-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3765

Referring to claim 1, second line, the words "the three-dimensional configuration" lack a proper antecedent basis.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7,12-17,22-33,38-43, 45,46 and 48 are rejected under 35 U.S.C. § 102(b) as being anticipated by Palermo et al. (5,925,059).

Palermo et al. teach a vaso-occlusive element and the method for forming the element including the step of injection molding a polymeric material into a three-dimensional configuration. Palermo et al. teach the element comprising an embolic coil formed of copolymers (column 7, lines 10-26) and having a radiopaque marker 128 (column 7, lines 10-26) for positioning the element inside the aneurism. The element comprises a cylindrical configuration with a longitudinal axis and channels running perpendicular to the longitudinal axis. The element includes discrete end portions which are removably connected to a device for insertion into the vasculature and wherein the end portions include surface means for connection to the pusher of the element or another coil (column 6, lines 46-49). Accordingly, Palermo et al. teach the element comprising a plurality of shaped structures, formed of first and second

Art Unit: 3765

portions, linked or strung in series and movable as a chain into position by using the mating surfaces of the end portions of the elements (column 6, lines 52-56). Palermo et al. further teach the placing of aneurism elements in the vasculature and disassociating these from pusher rods by applying an electrical discharge or localized heat to the ends of elements (column 2, lines 17-62).

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[©] of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3,24,26-30,47 and 48 are rejected under 35 U.S.C. § 102(e) as being anticipated by Boock (6,309,367).

Boock teaches a vaso-occlusive element and the method for forming the element including the step of injection molding a polymeric material into a three-dimensional configuration. Boock teaches the element comprising an embolic shield formed of

Art Unit: 3765

biocompatible, bioactive copolymers (column 3, lines 10-23) and having a radiopaque marker (column 3, line 55) for positioning the element inside the vasculature. The element comprises a cylindrical configuration with a longitudinal axis and forms a single molded element with retaining rings for assuring the proper placement of the occluder in the vasculature.

Claims 1,2,4,5,11,19,21,24-27,30,31,37,48 and 49 are rejected under 35 U.S.C. § 102(e) as being anticipated by Marotta et al. (6,261,305).

Marotta et al. teach a vaso-occlusive element and the method for forming the element including the step of injection molding a polymeric material into a three-dimensional configuration. Marotta et al. teach the element comprising an embolic shield formed of a polymer. The element comprises a cylindrical configuration with a longitudinal axis and forms a single molded element with micromachined channels for forming a hinge flap. The occluder is threaded through the vasculature and placed in such a position that the hinged flap is swung into position and occludes the aneurism rings for assuring the proper placement of the occluder in the vasculature.

DRAWINGS

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ovoid, spherical, conical and pyramidal shapes (claims 8-10 and 34-36) of the elements and the two or more elements detachably connected to the pusher (claims 12-14,16,38 and 40) must be shown or the feature canceled from the claim. No new matter should be entered.

Art Unit: 3765

ALLOWABLE SUBJECT MATTER

Claims 8-10,18 and 20 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

Claims 34-36 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

PERTINENT CITATIONS

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Khosravi illustrates an occluder including occlusive flaps. Heishima et al. illustrate an occluder including a wire wrapped in a polymer. Brill illustrates a balloon including a longitudinal axis and a multiplicity of shapes. Gifford et al. illustrate an aneurism occluder.

INQUIRIES

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-0861.

Any facsimile communication filed should be done so using group facsimile numbers (703) 305-3463 or (703) 305-3464.

Any inquiry concerning this communication or earlier communications directed to the examiner should be directed to Mr. Ismael Izaguirre at (703) 308-0892 located in CP2-4B18, Monday through Friday 9:30am to 6:00pm.



Ismael Izaguirre
Primary Examiner
Group Art Unit 3765

II
September 20, 2002